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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/158,728	09/22/1998	STEVEN CRAIG WEIRATHER	310048-355	4296

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LOS ANGELES, CA 900673024

EXAMINER

CHEVALIER, ALICIA ANN

ART UNIT	PAPER NUMBER
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1772

39

DATE MAILED: 07/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/158,728

Applicant(s)

WEIRATHER ET AL.

Examiner

Alicia Chevalier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 429-477 is/are pending in the application.
- 4a) Of the above claim(s) 436 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 429-435 and 437-477 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 37.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

RESPONSE TO AMENDMENT

1. Newly submitted claim 436 is directed to a non elected species (C) ~~from~~ a previous restriction requirement, see paper #32, page 2, Group: Facestock Sheet Construction Material. Applicant elected to prosecute species F in paper #34, filed January 28, 2003. Accordingly, claim 436 is withdrawn from consideration as being directed to a non-elected invention.

NEW REJECTIONS

2. **The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.**

Claim Rejections - 35 USC § 103

3. Claims 429-435, 437-451, 453-462, 470, 474, 475 and 477 are rejected under 35 U.S.C. 103(a) as being unpatentable over Popat et al. (5,407,718) in view of Cross (4,863,772).

Popat discloses a sheet of printable media comprising a facestock sheet construction (facestock sheet/cardstock sheet and an adhesive) and a solid/continuous release liner. The facestock sheet construction comprises through-cut lines (vertical and horizontal) through the facestock sheet but not through the release liner. The through-cut lines on the facestock sheet define a perimeter around the printable media and the printable media directly abut one another and share common edges which is arranged in a matrix. The facestock sheet also comprises frame cut lines and waste border around the printable media. The release line covers all the back

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side of all the face cut lines and extends the entire width of the facestock sheet construction. See figures 1 and 2.

Popat discloses all the limitations of the instant claimed invention except for the facestock construction being a dry laminate and the release liner comprising bleach kraft paper.

Cross discloses label stock with dry separation interface comprising a facestock paper, a pressure-sensitive adhesive, a layer of low density polyethylene (film), and denisified bleached kraft paper release layer (figure 5 and col. 5, lines 1-38).

Cross discloses the claims invention except for the adhesive being a hot melt adhesive or the film layer being polyester. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a hot melt adhesive for the adhesive or polyester for the dry release film layer, since it have been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended. *In re Leshin*, 125 USPQ 416.

It would have been obvious to one having ordinary skill in the art use the dry release label stock of Cross as the label facestock sheet construction of Popat because the dry release material would allow the labels of Popat to be nonsticky. One of ordinary skill in the art would be motivated to use a nonsticky label depending upon its intended use. Furthermore, it would have been obvious to one of ordinary skill to use a bleached kraft release liner in Popat when using a dry release label stock as taught by Cross because it has better release properties.

The exact thickness of the layers is deemed to be a cause effective variable with regard to size of paper acceptable for sending through a printer. It would have been obvious to one having ordinary skill in the art to have determined the optimum value of a cause effective variable such

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as combined thickness of layers through routine experimentation in the absence of a showing of criticality in the claimed combined thickness. *In re Boesch*, 205 USPQ 215 (CCPA 1980), *In re Woodruff*, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990). One of ordinary skill in the art would have been motivated to change the size of the layers in order to accommodate the machine in which the sheet was intended to be used in.

The limitation(s) “when the sheet of printable business cards is fed through a printer or copier for printing operation on the printable business cards” in claim 429 is (an) intended use limitation(s) and is not further limiting in so far as the structure of the product is concerned. “[I]n apparatus, article, and composition claims, intended use must result in a ***structural difference*** between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. ***If the prior art structure is capable of performing the intended use, then it meets the claim.*** In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art.” [emphasis added] *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967); *In re Otto*, 312 F.2d 937, 938, 136 USPQ 458, 459 (CCPA 1963). See MPEP § 2111.02. As such claim 470 does not further limit the claims because does not add structure to the claim. This is because claim 470 further limits the intended use phrase from claim 429.

Process limitations are given little or no patentable weight. The method of forming the product is not germane to the issue of patentability of the product itself. Further, when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claim in a product-by-process claim, the burden is on the Applicant to present evidence from which the Examiner could reasonably conclude that the claimed product

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differs in kind from those of the prior art. *In re Brown*, 459 F.2d 531, 173 USPQ 685 (CCPA 1972); *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974). This burden is NOT discharged solely because the product was derived from a process not known to the prior art. *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974).

Furthermore, the determination of patentability for a product-by-process claim is based on the product itself and not on the method of production. If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 946, 966 (Fed. Cir. 1985) and MPEP §2113. In this case, the limitations “the liner sheet is extrusion coated on one side with the film layer” – claim 430, “the extruded film layer on the liner sheet is laminate to the adhesive layer on a back side of the cardstock sheet” – claim 431, “the through-cut lines are die-cut lines” – claim 462 are methods of production and therefore does not determine the patentability of the product itself.

4. Claims 463 and 464 are rejected under 35 U.S.C. 103(a) as being unpatentable over Popat et al. (5,407,718) in view of Cross (4,863,772) as applied to claims 429-435, 437-451, 453-462, 470, 474, 475 and 477 above, and further in view of Hickenbotham et al. (4,704,317).

Popat and Cross disclose all the limitations of the instant claimed invention except for card sheet of paper sheet is calendered.

Hickenbotham discloses crushing the corner of lablestock for use in printers or copier to provide a diagonal path of relatively low stiffness (col. 6, lines 9-16). The low stiffness in the front edge of the sheet allows the sheet to be dispensed through the printer or copier with greater easier (col. 1, lines 38-51).

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It would have been obvious to one of ordinary skill in the art at the time of the invention to crush the edge of the combination of Popat and Cross as similarly taught by Hickenbotham. One of ordinary skill would be motivated to crush the edge of the combination of Popat and Cross because crushing the edge of the combination of Popat and Cross would provide a path of relatively low stiffness and would make the sheet of the combination of Popat and Cross easier to be dispensed through a printer.

5. Claims 452 and 476 are rejected under 35 U.S.C. 103(a) as being unpatentable over Popat et al. (5,407,718) in view of Cross (4,863,772) as applied to claims 429-435, 437-451, 453-462, 470, 474, 475 and 477 above, and further in view of Carlson (5,842,722).

Popat and Cross disclose all the limitations of the instant claimed invention except for card sheet/ facestock sheet is coated.

Carlson discloses a sheet for preparing business forms including die cut cards, which includes an ink receptive coating (abstract and col. 19, line 50 through 3).

It would have been obvious to one of ordinary skill in the to add an ink receptive coating to the combination of Popat and Cross as taught by Carlson because it would enhance the adhesion of the ink to the card.

6. Claims 465-469 and 471-473 are rejected under 35 U.S.C. 103(a) as being unpatentable over Popat et al. (5,407,718) in view of Cross (4,863,772) as applied to claims 429-435, 437-451, 453-462, 470, 474, 475 and 477 above, and further in view of Klein (5,198,275).

Popat and Cross disclose all the limitations of the instant claimed invention except for the liner sheet including a cut line.

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Klein discloses a card stock sheet for making business cards (col. 2, line 47) or a label (col. 3, line 13) comprising a lift out panel (cardstock sheet) with rectangular score cuts (cut lines), an adhesive, and a backing sheet (liner sheet) with perforations (liner sheet cut lines) (figure 6). From figure 3 the laminate member can be seen to have rectangular score cuts (frame cut lines) and score cuts (grid cut lines) and the matrix of cards is surrounded by a waste facestock sheet perimeter.

The exact distance of the liner sheet cut lines to the end of the sheet is deemed to be a cause effective variable. It would have been obvious to one having ordinary skill in the art to have determined the optimum value of a cause effective variable such as distance of liner sheet cut line to the end of the sheet through routine experimentation in the absence of a showing of criticality in the claimed combined thickness. *In re Boesch*, 205 USPQ 215 (CCPA 1980), *In re Woodruff*, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990).

It would have been obvious to one of ordinary skill in the art at the time of the invention to add liner cut lines to the combination of Popat and Cross as taught by because it would make peeling the liner off the stock material easier.

ANSWERS TO APPLICANT'S ARGUMENTS

7. Applicant's arguments filed in paper #38 regarding the new claims have been considered but are deemed unpersuasive.

Applicant argues that the claim 429 is directed to a sheet of printable business card (not adhesive labels). The preamble language "a sheet of printable business cards" is (an) intended use limitation(s) and is not further limiting in so far as the structure of the product is concerned.

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“[I]n apparatus, article, and composition claims, intended use must result in a *structural difference* between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. *If the prior art structure is capable of performing the intended use, then it meets the claim.* In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art.” [emphasis added] *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967); *In re Otto*, 312 F.2d 937, 938, 136 USPQ 458, 459 (CCPA 1963). See MPEP § 2111.02.

Applicant further argues that this sheet of printable business cards as claimed in claim 429 is not taught by or suggested by any of the references of record, individually or in any combination of their teachings. The examiner disagrees for the reasons set forth above in the grounds of rejection over the new claims.

Applicant also argues that Popat relates to adhesive labels and Casagrande uses two adhesives. The fact that both Popat and Casagrande include additional structure not required by Applicant's invention, it must be noted that they both disclose the invention as claimed. The fact that they disclose additional structure not claimed is irrelevant since applicant use open claim language; “comprising”.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

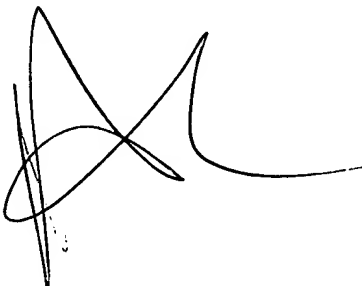
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (703) 305-1139. The Examiner can normally be reached on Monday through Thursday from 8:00 a.m. to 5:00 p.m. The Examiner can also be reached on alternate Fridays

If attempts to reach the Examiner are unsuccessful, the Examiner's supervisor, Harold Pyon can be reached by dialing (703) 308-4251. The fax phone number for the organization official non-final papers is (703) 872-9310. The fax number for after final papers is (703) 872-9311.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose phone number is (703) 308-0661.

ac

7/23/03



ALEXANDER S. THOMAS
PRIMARY EXAMINER